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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,487	01/23/2001	Brian J. Maroney	1671-0172	3262

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EXAMINER

ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

DATE MAILED: 11/05/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,487

Applicant(s)

MARONEY, BRIAN J.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to RCE

This is a response to the RCE filed October 1, 2003. Claims 21-30 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsen, III in US Patent No. 5,885,297 in view of Trail in EP 0845250.

Regarding claims 21 and 26, Matsen, III discloses a surgical procedure via advancing a broach (such as 26", 76", etc.) into a medullary canal of a humerus, as stated in column 6, lines 15-30; securing a guide assembly (such as 46 with 30", etc.) to the broach (26", 76", etc.) while the broach is located within the medullary canal of the humerus; as seen in figures 1-7; and with a cutting tool, the resecting step including guiding the cutting tool with the guide assembly while the guide assembly is secured to the broach and the broach is located within the medullary canal of the humerus, as recited in column 6 and column 7. However, Matsen, III does not explicitly recite resecting a greater tubercle of the humerus. On the other hand, Trail discloses an apparatus such that the greater tubercle would be required to be resected in order for proper placement. Given area 6 as shown in figure 1, the greater tubercle would necessarily be required to be removed

Art Unit: 3743

from proper placement. The device of Trail is not unlike that disclosed in the current application requiring removal of the greater tubercle. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Matsen, III to cut the greater tubercle when a replacement device such as Trail is to be implemented, for in order for proper fit would necessarily require removal of the greater tubercle. It is well within the scope of the invention to modify that disclosed by Matsen, III to be sized and shaped accordingly to properly resect the greater tubercle. Further, applicant's attention is drawn to page 17 of the current application specification which recites, "Moreover, either the support block 52, or the guide block 54, 56 themselves, may utilize a positioning member which allows the blocks 52, 54, 56 to be secured directly to the humerus 22 thereby eliminating the need to utilize a surgical instrument (e.g. the broach 68, reamer 70, trial implant stem, or implant stem) as a positioning member. Thus, the method in which to cut the greater tubercle has not been established as critical. As such, any method that cuts the greater tubercle in order for proper placement of the apparatus of Trail (not unlike applicant's disclosed apparatus) would be deemed equivalent in function of resecting the greater tubercle for proper placement of the device. Further, applicant's specification recites on page 23, "Once the surgeon has completed his or her use of the rasp or rongeur, the broach 68 is extracted from the medullary canal 22." Therefore, the broach is not critical to the implantation of the prosthesis.

Regarding claims 22 and 27, Matsen, III as modified by Trail discloses that as applied to claims 21 and 26 as well as a guide assembly (such as 46 with 30", etc) that includes a

tool guide member (such as 58) and a support block (30", etc.), the securing step includes attaching the support block to the broach and the guiding step includes guiding the cutting tool with the guide member. Although the tool guide member is integrally attached to the support block it would be obvious to one having ordinary skill in the art at the time the invention was made to make the device in separate pieces, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Regarding claims 23 and 28, Matsen, III as modified by Trail discloses that as applied to claims 22 and 27 including a support block that includes a channel (such as 34). However, although a tool guide that includes a projection configured to mate with the channel in a dove-tail relationship has not been explicitly recited, the current specification does not demonstrate the criticality of the dove-tail relationship, thus the channels and projection demonstrated in Matson III can be considered equivalents since their function is equivalent is accurate guiding for proper resection.

Regarding claims 24 and 29, Matsen, III as modified by Trail discloses that as applied to claims 21 and 26 including an advancing step that includes that step of advancing the broach into the medullary canal of the humerus so that a collar of the broach sits substantially flush with a resected surface of the humerus and the securing step includes the step of securing the guide assembly to the broach while the collar of the broach sits substantially flush with the resected surface of the humerus. The

modification of Matsen, III for cutting the greater tubercle would necessarily demonstrate this limitation.

Regarding claims 25 and 30, Matsen, III as modified by Trail discloses that as applied claims 22 and 27 as well as a support block (30", etc.) that has a passageway (such as 34) extending therethrough; and a broach (such as 26", etc.). However, Matsen, III does not explicitly recite a broach that has defined therein a bore having an internally threaded portion; and the step of attaching the support block to the broach includes that step of advancing an externally threaded fastener through the passageway of the support block and into threading engagement with the internally threaded portion of the bore defined in the broach. On the other hand, it would be obvious to one with ordinary skill in the art to further modify the invention of Matsen, III to include threaded attachment for the support block and the broach for the purpose of secured attachment and proper placement, for it involves only routine skill in the art to modify an invention for threaded attachment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone

Application/Control Number: 09/767,487

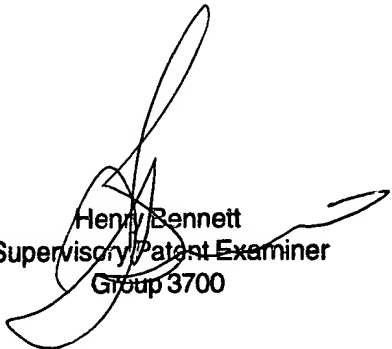
Page 6

Art Unit: 3743

number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO



Henry Bennett
Supervisory Patent Examiner
Group 3700